

R E M A R K S

Claims 1 to 34 were pending in the present application.

Claims 1, 25, 28, 31, 33, and 34 were pending independent claims.

Claims 1 to 34 will be pending upon entry of this Amendment, and

Claims 1, 25, 28, 31, 33, and 34 will be the pending independent claims upon entry of this Amendment.

Applicants have amended claim 1 for purposes of clarification by reciting what was implicit. No amendment was made for a reason related to patentability.

Section 102(b) and 103(a) Rejections

Claims 1-5, 7-9, and 19-33 are rejected as being unpatentable under 35 U.S.C. 102(b) over Nelson. Claims 10-12, 16-18, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Lofink. Applicants traverse the Examiner's Section 102(b) and 103(a) rejections

Applicable Law

During examination, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art.

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.

When a rejection is based on a combination of references, the Examiner can satisfy the *prima facie* burden only by showing some objective teaching leading to the purported

combination of references. Lacking a motivation to combine references, there is no *prima facie* case of obviousness.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Furthermore, **particular findings must be made** as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. (emphasis added).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. **In the absence of such a showing**, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. (emphasis added) The absence of such a suggestion to combine is dispositive in an obviousness determination. (emphasis added).

When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. In each case the factual inquiry whether to combine references must be thorough and searching.

The Claim Rejections

Each claim is discussed below in light of the rejection. In summary, a *prima facie* showing of unpatentability has not been made for any claim.

Independent Claims 1, 25, 28, 31, 33, 34

Limitations:

The Examiner has not shown that any of the prior art of record discloses “based on a random outcome, determining if the player has won the hand of blackjack”, variations of which are recited in the following claim limitations:

independent claim 1:

based on a random outcome, determining if the player has won the hand of blackjack

independent claim 25:

based on a random outcome, determining if the player has won at least one of the plurality of the hands of blackjack

independent claims 28:

based on a random outcome, determining if the plurality of players have won the plurality of the hands of blackjack

independent claim 31:

based on a random outcome, determining if the player has won the first and second hands of blackjack

independent claim 33:

transmitting a random outcome in response to said receiving, the random outcome determining if the player has won the hand of blackjack

independent claim 34:

based on the random outcome, determining if the player has won the hand of blackjack

Nelson, in fact, teaches the opposite. Namely, Nelson teaches determining if a player wins based on a player's "skill in arranging...cards between the front and back hands" (col. 4, lines 59-60), not based on a "random outcome". Clearly something based on skill is opposite to something based on a random event.

Nelson goes so far as to provide particular strategies for winning should a player's front hand be involved in a tie.

If there is a tie (enclosure 70), the dealer turns over back hand 26 of the action player (player 20a). Using the rules of the game of Poker, the cards are examined (enclosure 74) to provide a winner (enclosure 76) and a loser (enclosure 78). (col. 5, lines 52-56)

Skill is present in the arrangement of the playing pieces between the front and the back hands. Experience has determined that a tie occurs more than 50 percent of the time; therefore, skill becomes an important factor. For example, if a participant's four cards comprise an ace, a king, a queen and an "8", the better play is to place the ace and the queen in the front hand, as totalling 21 points, and the king and "8" in the back hand. The king in the back hand might be a critical card and, as having a higher Poker value than the queen. (col. 6, lines 22-30)

In the quoted passage, Nelson advocates placing a king in a back hand rather than a queen, since the king has "a higher Poker value than [a] queen". A determination of the player's winning is not, therefore, based merely on a "random outcome".

The teachings of Lofink are also diametrically opposite to the claimed limitation. Lofink arguably teaches based on a random outcome, determining if a player has obtained a push in a hand that is otherwise winning. Lofink does not teach "determining if the player has won" a hand that is a push "based on a random outcome".

Lofink arguably teaches:

Either of the above two versions could be modified by using devices other than card point totals to establish a "push" or "bar" situation for what would otherwise be a winning hand. For example, separate mechanical or electrical devices can be used to establish that a particular round of play of Baccarat would be a winning hand "bar" round, i.e. a normal winning hand would be barred from winning during that particular round of Baccarat and instead would become a "push" hand. In one form of mechanical device, three dice are placed in a dice cup. (col. 7, lines 23-33)

Thus, Lofink clearly does not suggest the claimed limitation.

The Examiner also has not shown that any of the prior art of record discloses “determining that the hand of blackjack has resulted in a push”, variations of which are recited in the following claim limitations:

independent claim 1:

determining that the hand of blackjack has resulted in a push

independent claim 25:

determining that the plurality of hands of blackjack have resulted in a push

independent claims 28:

determining that the plurality of hands of blackjack have resulted in a push

independent claim 31:

determining that a first hand of blackjack has resulted in a first push

independent claim 33:

receiving an indication that the hand of blackjack has resulted in a push

independent claim 34:

determining that the hand of blackjack has resulted in a push

Nelson does not teach that a game of blackjack is played at all, let alone “determining that [a] hand of blackjack has resulted in a push.” The game taught by Nelson bears only superficial similarities to the game of Blackjack, but it is clearly not Blackjack.

Nelson does not describe the game of Blackjack, but does discuss a game very different from Blackjack, in which:

The house dealer deals (enclosure 48) four cards or tiles face down to each player (enclosure 50) and to the banker (enclosure 51). (col. 4, lines 32-34)

The players arrange their own pieces and generally place them (enclosure 50) into two piles. (col. 4, lines 49-50)

Some considerable degree of skill is required in arranging these cards between the front and back hands. The front hands for both the action player, and later, the banker are to be played first, according to a first set of rules which may, for example, be those of Blackjack or Twenty-one. When the order of prevalence for the front hand is determined, for example, by the conventional rules of Blackjack the limit is 21 and the objective is to get as close to 21 as possible without going over 21. In establishing the front hand a player may use one, or as many of the cards dealt as the player chooses, for the front hand. Since the player is setting the front hand it will not go over 21[sic] (col. 4, line 59 – col. 5, line 3)

The rules of play described in Nelson are quite different from the rules of conventional Blackjack, although Nelson teaches “an order of prevalence...determined...by the conventional rules of Blackjack”. For example, Nelson describes a game in which “four cards [are dealt] face down to each player.” In conventional Blackjack, a player begins with only two cards. Further, in Nelson, a player is limited to the initial four cards dealt, whereas in conventional Blackjack, a player has theoretically unlimited opportunities to obtain new cards, i.e., to “hit”. Further, Nelson describes a game in which a “hand will not go over 21” because “the player is setting” it. In Blackjack, players frequently “bust” by exceeding a certain total (e.g., 21). Going “bust” (i.e. exceeding a particular total) is an indispensable part of the game of Blackjack. These and many other significant differences between Nelson and conventional Blackjack demonstrate that Nelson is not describing a game of Blackjack.

Lofink has no mention of Blackjack whatsoever, let alone “determining that [a] hand of blackjack has resulted in a push”. Lofink teaches only “a modified method of playing Baccarat” (abstract). Clearly, Lofink would not suggest “determining that [a] hand of blackjack has resulted in a push”.

Motivation to Combine:

The Examiner states as a motivation to combine Nelson and Lofink that, “by having different types of generating device, one of ordinary skill in the art would provide game players a faster pace game while enticing participation from new players.” The Examiner’s motivation is not anywhere in the prior art of record. Specifically, no reference suggests that randomization is a key to speeding up play. Further, no reference suggests that randomization is a key to enticing new players.

References not Combinable:

Nelson is not combinable with Lofink, because Lofink accomplishes the opposite of what is intended by Nelson. Namely, Nelson seeks to quickly eliminate ties, whereas Lofink seeks to create them, albeit in a different game. In fact, combining the teachings of both references would create the very tied situations that Nelson seeks to avoid.

Nelson arguably teaches:

If there is a tie (enclosure 70), the dealer turns over back hand 26 of the action player (player 20a). Using the rules of the game of Poker, the cards are examined (enclosure 74) to provide a winner (enclosure 76) and a loser (enclosure 78). If there still exists a tie (enclosure 80), then the outcome is determined by the dealer according to predefined rules. Preferably, banker is declared the winner, simply as a matter of moving play to other players, before they tire of waiting. (col. 5, lines 52-60)

Thus, Nelson teaches the importance of quickly declaring a winner in a tied situation “simply as a matter of moving play to other players, before they tire of waiting”. In contrast, Lofink, as quoted above, seeks to “establish a "push" or "bar" situation for what would otherwise be a winning hand”. In summary, the two references clearly teach away from each other.

Remaining Claims

The remaining claims are dependent, and are patentable for at least the reasons discussed above for their respective base claims.

Miscellaneous

The Examiner has stated that “Applicant has not disclose [sic] generating a random outcome being performed prior to the determining the hand is a blackjack...” However, Applicants’ specification states:

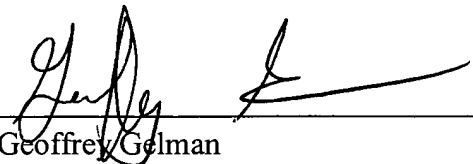
According to one embodiment, the random outcome is determined before the hand of blackjack resulted in a push. For example, the controller 200 may use a stored list of pre-generated random numbers to resolve the hand of blackjack. In this case, the pre-generated random outcome may be concealed from the player 20 until a push has been determined. (page 9, lines 15-19)

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Geoffrey Gelman at telephone number 203-461-7331 or via electronic mail at ggelman@WalkerDigital.com.

Respectfully submitted,



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